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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,310	02/26/2004	Makihiro Otohata	Q80032	3429

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EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,310

Applicant(s)

OTOHATA ET AL.

Examiner

Julian Mercado

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2007-09-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed on September 4, 2007.

Claims 1-10 are pending.

Drawings

The drawings filed on February 26, 2004 are accepted by the examiner.

Claim Rejections - 35 USC § 112

The rejection of claims 1-10 under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

The rejection of claims 1, 4-6, 9 and 10 under 35 U.S.C. 102(b) based on Sonozaki et al. (U.S. Pat. 6,106,973) has been withdrawn.

The examiner concedes that as shown in Figure 11 of Sonozaki et al., the casing is from a unitary sheet [95A] which is then folded in the configuration shown. Accordingly, applicant's assertion that the patentees do not teach two halves such as in Figure 4 of applicant's disclosure is persuasive. (emphasis as submitted)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 2002-298825. (hereinafter JP '825)

The examiner notes applicant's amendment to claim 1 which appears to have been submitted in order to obviate the 35 U.S.C. 112, second paragraph (now withdrawn). The examiner concedes that the claims are presented in more definite form, however, the scope of the present claims are considered substantially the same as that presented in the prior Office action. Accordingly, the rejection based on JP '825 is maintained for the reasons of record.

Applicant's arguments filed with the present amendment have been fully considered, however they are not found persuasive. The examiner's reply to each of applicant's salient arguments here follows: Applicant submits that JP '825 does not teach each of the lead terminals being connected to the battery element at a position inside of both surfaces. (emphasis as submitted) It appears to the examiner that applicant intends to claim a connection to *the inside* of both surfaces. (emphasis in the direct object noun *inside*) However, the present claims merely recite connection at a *position* inside of both surfaces (emphasis in the direct object noun *position*). Thus, JP '825 is maintained to teach that the terminals [1, 2] are in a position inside both surfaces defined by the space between collector [4a] and separator [6], as shown in Figure 6.

For claim 6, applicant submits that the leading end of the terminal in JP '825 is not beyond the second surface of the battery element. (emphasis as submitted) In reply, the

examiner asserts that the terminal does extend beyond either of the first and second surfaces, as shown in Figures 5 and 6, where the terminal extends beyond in the lateral direction, i.e. to the right of the page.

For claim 9, the examiner asserts that a left connection and a right connection are readable on the claimed "sides of said battery element different from each other."

Claims 1, 4, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lake (U.S. Pat. 5,326,652).

As stated above, the examiner notes applicant's amendment to claim 1 which appears to have been submitted in order to obviate the 35 U.S.C. 112, second paragraph (now withdrawn). The rejection based on Lake is maintained for the reasons of record.

Applicant's arguments filed with the present amendment have been fully considered, however they are not found persuasive. Applicant's argument is one-fold and is directed to dependent claim 9 only: that Lake teaches connection of the terminals to the same side rather than different sides as claimed. This is not persuasive, as the examiner asserts that a left-side connection and a right-side connection are readable on "sides... different from each other."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-298825.

The rejection is maintained for the reasons of record. Applicant's assertion of unexpected results is noted, however they are not found persuasive. Applicant's arguments are silent as to the *criticality* of the dimensions claimed. The specification also does not appear to show an unexpected result dependent on the *magnitude* of the claimed battery thickness of 3 mm or more or the positioning of the charge collectors or terminals at 1 mm or more. Thus, the examiner maintains that the claimed dimensions fall within the purview of the skilled artisan as an obvious matter of design choice.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Application/Control Number:
10/786,310
Art Unit: 1795

Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



jam



PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER